

1624

PTO/SB/21 (09-04)

# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

26

Application Number

10/044,486

Filing Date

January 11, 2002

First Named Inventor

Tsien, Roger Y.

Art Unit

1624

Examiner Name

Mark Berch

Attorney Docket Number

02307E-152710US

## ENCLOSURES (Check all that apply)

- |                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                       |                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                 |                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                        |
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| <input type="checkbox"/> Fee Transmittal Form<br><input type="checkbox"/> Fee Attached<br><input type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input checked="" type="checkbox"/> Information Disclosure Statement<br><br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Reply to Missing Parts/ Incomplete Application<br><input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation<br>Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) _____<br><input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC<br><input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences<br><input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):<br>Form PTO/SB08/A, B, EP search report, 5 references, return postcard |
|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

Remarks The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Townsend and Townsend and Crew LLP		
Signature			
Printed name	Kenneth E. Jenkins		
Date	April 26, 2005	Reg. No.	51,846

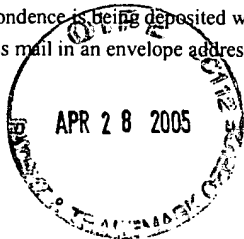
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Signature			
Typed or printed name	Timothy S. Parker	Date	April 26, 2005

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PATENT  
Attorney Docket No.: 02307E-152710US  
Client Reference No.: 2000-473-2

On April 26, 2005

TOWNSEND and TOWNSEND and CREW LLP

By: Timothy J. Parker

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Roger Y. Tsien, et al.

Application No.: 10/044,486

Filed: January 11, 2002

For: BETA-LACTAMASE  
SUBSTRATES HAVING PHENOLIC  
ETHERS

Examiner: Mark Berch

Art Unit: 1624

SUPPLEMENTAL INFORMATION  
DISCLOSURE STATEMENT UNDER 37  
CFR §1.97 and §1.98

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The references cited on attached form PTO/SB/08A and PTO/SB/08B are being called to the attention of the Examiner. Copies of the references are enclosed.

Also enclosed is a copy of a European Search Report which was issued in corresponding European application no. 02720779.4, and in which these references were cited.

04/29/2005 MAHME1 00000060 201430 10044486

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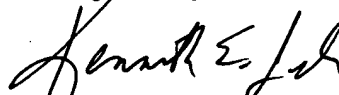
It is respectfully requested that the cited references be expressly considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue therefrom.

As provided for by 37 CFR 1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no representation is being made that a search has been conducted or that this statement encompasses all the possible relevant information.

This IDS is being filed before the mailing date of the final Office Action or Notice of Allowance.

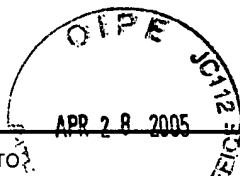
Please charge the IDS fee of \$180 to Deposit Account No. 20-1430. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

Respectfully submitted,



Kenneth E. Jenkins  
Reg. No. 51,846

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
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KEJ:tsp



Substitute for form 1449A/PTO.

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(use as many sheets as necessary)

Sheet

1

of

2

**Complete if Known**

Application Number	10/044,486
Filing Date	January 11, 2002
First Named Inventor	Tsien, Roger Y.
Art Unit	1624
Examiner Name	Mark Berch
Attorney Docket Number	02307E-152710US

**U.S. PATENT DOCUMENTS+**

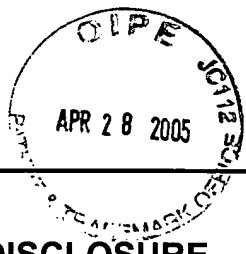
Examiner Initials*	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number Kind Code <sup>2</sup> (if known)			
	AA	US-			
	AB	US-			
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	AF	US-			
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	AH	US-			
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**FOREIGN PATENT DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document			Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup> (if known)				
	AU	EP	0553741	A2	08/04/1993	Quante, et al.		<input type="checkbox"/>
	AV							<input type="checkbox"/>
	AW							<input type="checkbox"/>
	AX							<input type="checkbox"/>
	AY							<input type="checkbox"/>
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<b>Substitute for form 1449B/PTO</b>  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  (use as many sheets as necessary)				<b>Complete if Known</b>	
				Application Number	10/044,486
				Filing Date	January 11, 2002
				First Named Inventor	Tsien, Roger Y.
				Art Unit	1624
				Examiner Name	Mark Berch
Sheet	2	of	2	Attorney Docket Number	02307E-152710US

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials *	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
	BC	Prasanna de Silva, A., et al. "Emerging fluorescence sensing technologies: From photophysical principles to cellular applications", <i>Proc. Natl. Acad. Sci USA</i> (1999) 96:8336-8337	
	BD	Anderson Ellen G. et al. "Pre-Steady State $\beta$ -Lactamase Kinetics", <i>The Journal of Biological Chemistry</i> (1981) 256(22): 11401-11404	
	BE	Zlokarnik, Gregor, et al. "Quantitation of Transcription and Clonal Selection of Single Living Cells with $\beta$ -Lactamase as Reporter", <i>Science</i> (1998) 279(2):84-88	
	BF	Gao, Wenzhong, et al. "Novel Fluorogenic Substrates for Imaging $\beta$ -Lactamase Gene Expression", <i>J. Am. Chem. Soc.</i> (2003) 125:11146-11147	
	BG		
	BH		
	BI		
	BJ		
	BK		
	BL		
	BM		

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